

Application No. 10/660,461
Inventor: Christopher J. Calhoun
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REMARKS

Applicant has amended claims 1-3 and 22-24, and has cancelled claim 21. Care had been taken to avoid the introduction of new matter. Claims 1-11 and 22-24 are presently pending in the application.

Applicants would like to thank Examiner Casey Shea Hagopian for her thorough search and review of the prior-art, her careful consideration and examination of the present application and claims, and her indication on page 8 of the Office Action that the prior-art rejection of independent claim 1 and dependent claims 4-11 has been withdrawn. Applicants have amended the current application so that all claims now depend ultimately from independent claim 1. Accordingly, it is respectfully submitted that the current claims in the subject application patentably distinguish over, and are allowable over, the prior art of record.

The Office Action rejected claims 1, 2-11 and 22-24 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Regarding this rejection, the Examiner contended that the claim limitation of a membrane "consisting essentially of one or more of a poly-lactide polymer and a copolymer of two or more different lactides" is not supported in the as-filed application.

Applicant respectfully disagrees with this rejection, and directs the Examiner's attention, for example, to the thirteenth paragraph of Applicant's Detailed Description, which states that the membranes "can include polylactide polymers and/or co-polymers." This language of a membrane that "can include polylactide polymers" certainly contemplates a membrane having more than one polylactide polymer, and the language of a membrane that "can include ... co-polymers" certainly contemplates a membrane having more than one copolymer. Thus, the queried claim language would appear to be supported in the as-filed patent application in such a manner as to meet the requirements of the relevant patent statute.

In any event, Applicant has amended the queried language of claim 1. In particular, the queried phrase in claim 1 has been amended to recite that the membrane is constructed from a resorbable polymer base material selected from the group consisting essentially of (a) a poly-

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lactide polymer, (b) a copolymer of lactides, and (c) a poly-lactide polymer and a copolymer of lactides. Claim 1 has been amended based upon support which can be found, for example, in one or more of (a) the current Summary and Detailed Description and (b) U.S. Patent No. 6,531,146 which is incorporated by reference into the specification of the subject patent application. Accordingly, it is submitted that support exists in the as-filed application for the subject matter pertaining to the claim language "consisting essentially of one or more of a poly-lactide polymer and a copolymer of two or more different lactides" and that, furthermore, the support is of a nature such as to reasonably convey to one skilled in the relevant art that the inventor at the time the application was filed had possession of the claimed invention.

Applicants submit that claim 1, even before the entering of the current amendment, was sufficiently definite, contained sufficient utility, and was adequately supported, to fully meet the requirements of 35 U.S.C. § 112. Accordingly, it is Applicant's opinion the rejection under 35 U.S.C. § 112, first paragraph, was not properly imposed by the Office Action. The amendment to claim 1 has been made, not so much as to overcome the rejection but rather to further define one or more aspects of the present invention. For example, claim 1 has been amended to further define the various permutations encompassed by the language of a "material consisting essentially of one or more of a poly-lactide polymer and a copolymer of two or more different lactides." The Examiner is requested to reconsider and withdraw the rejection under the first paragraph of 35 U.S.C. § 112.

The Office Action rejected claims 1, 2-11 and 22-24 under 35 U.S.C. § 112, first paragraph, as allegedly failing, in particular, to provide enablement. In particular the Examiner alleged that the specification, while admittedly being enabling for a membrane of a poly-lactide polymer and a copolymer, is not enabling for the claim limitation of a membrane "consisting essentially of one or more of a poly-lactide polymer and a copolymer of two or more different lactides." Applicant respectfully disagrees, and directs the Examiner's attention once again to the thirteenth paragraph of Applicant's Detailed Description, which states that the membranes "can include polylactide polymers and/or co-polymers." This language clearly would reasonably convey to one skilled in the relevant art that the inventor at the time the application

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was filed had possession of the claimed invention including a membrane having more than one polylactide polymer and more than one copolymer.

Regarding Applicant's amendment of the queried language of claim 1 to recite that the membrane is constructed from a resorbable polymer base material selected from the group consisting essentially of (a) a poly-lactide polymer, (b) a copolymer of lactides, and (c) a polylactide polymer and a copolymer of lactides, it is reiterated that this language has been implemented to further define one or more aspects of the present invention rather than to overcome the subject rejection. Claim 1 has been amended based upon support which can be found, for example, in the above-mentioned Summary and Detailed Description of the current application, and in the referenced U.S. Patent No. 6,531,146. In view of the preceding, the Examiner is requested to reconsider and withdraw the rejections under 35 U.S.C. § 112, first paragraph.

The Office Action rejected claims 2 and 3 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, and rejected claims 22-24 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In response, claims 2, 3 and 22-24 have been amended to address the queried concerns. Reconsideration and withdraw of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested.

The Office Action also rejected claim 21 on prior-art. Regarding this prior-art rejection, claim 21 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Totakura et al. (U.S. Patent No. 5,795,584). Applicant respectfully disagrees with this rejection and submits that, in any event, it is now moot as a result of claim 21 being cancelled by way of the entering of this Amendment. Accordingly the outstanding rejection under 35 U.S.C. § 103(a) is now without merit.

In view of the foregoing amendments and remarks, it is respectfully submitted that independent, amended claim 1, and the claims dependent therefrom, are neither anticipated nor rendered obvious by Totakura et al., taken separately or together with any other reference of

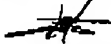
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record. Applicant accordingly requests that the rejection based on Totakura et al. be reconsidered and withdrawn.

Allowance of all presently pending claims is respectfully requested. If a telephone conversation with Applicant's attorney would expedite the prosecution of the above-identified application, the Examiner is urged to call Applicant's attorney at the below number.

Respectfully submitted,


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